

Atty. Dkt. No. SALK1470-2
(088802-1852)

REMARKS

In accordance with the present invention, there are provided methods for testing a compound for its ability to regulate transcription-activating effects of a peroxisome proliferator activated receptor-gamma (PPAR- γ). Invention methods comprise assaying for changes in the level of reporter protein present as a result of contacting cells containing PPAR- γ (either endogenous to the host cell or introduced recombinantly) and a reporter vector with the test compound of interest. Compounds identified employing invention methods are useful in the treatment of pathological conditions such as diabetes.

Claims 16, 18-20 and 27-45 were pending before this communication. By the present communication, claims 27, 36 and 44 have been amended to define Applicants' invention with greater particularity. No new matter is added by the subject amendments as the amended claim language is fully supported by the specification and original claims. In addition, Claims 29-35 and 37-39 have been cancelled without prejudice. The amendments submitted herewith not only reduce the total number of claims under consideration, they are also respectfully submitted to place the remaining claims in condition for allowance, or at a minimum, in better condition for appeal. Accordingly, entry of the amendments submitted herewith is respectfully requested.

Upon entry of the amendments submitted herewith, claims 16, 18-20, 27, 28, 36 and 40-45 will remain pending. The present status of all claims in the application, and current amendments thereto are provided in the listing of claims presented herein beginning on page 2.

The indication that claims 16, 18-20, 28, 43 and 45 are allowable is acknowledged with appreciation.

The objection to the declaration is acknowledged and will be addressed upon allowance of the present claims.

The objection to claim 38 as being dependent on a rejected base claim has been rendered moot by the cancellation thereof. By the present communication, the requirements of claim 38

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have been incorporated into claim 36, which is now respectfully submitted to be in condition for allowance.

The rejection of claim 27 under 35 U.S.C. § 102(b) as allegedly being anticipated by Marcus et al., Proc of the Natl Acad. of Sci USA 90:5723-5727 (1993) is respectfully traversed. Applicants' invention, as defined by claim 27, distinguishes over Marcus by requiring contacting test cells with at least two exogenous compounds. In the context of an assay, one could not contact test cells with test compound without introducing compound that was not already in the test system. Thus, it is respectfully submitted to be clear that the compounds with which test system is contacted are exogenous to the test cells. In contrast, as acknowledged by the Examiner "Marcus does not teach contacting the cells with two exogenous compounds." (See page 4, lines 3-4 of the Office Action). Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

The rejection of claims 36, 37 and 39-42 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Webster et al., Cell 54:199-207 (1988) in view of Greene et al., U.S. Patent No. 6,200,802, is respectfully traversed and has been rendered moot by the amendments submitted herewith. Thus, by the present communication, the requirements of claim 38 (which is not subject to this rejection) have been incorporated into claim 36. Accordingly, this rejection is no longer applicable to claim 36 and claims dependent thereon.

The rejection of claim 44 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Webster in view of Greene and Ikonen, et al., Endocrinology 135:1359-1366 (1994) is respectfully traversed and has been rendered moot by the amendments submitted herewith wherein the requirements of claim 38 (which is not subject to this rejection) have been incorporated into claim 44. Accordingly, it is respectfully submitted that this rejection is not applicable to claim as amended.

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CONCLUSION

In view of the above amendments and remarks, reconsideration and favorable action on all claims are respectfully requested. In the event any matters remain to be resolved in view of this communication, the Examiner is encouraged to call the undersigned at the number given below so that a prompt disposition of this application can be achieved.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

Date 5/11/04

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